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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,725	08/17/2001	Shigeru Yano	018793-251	3808

7590

08/12/2003

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EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,725

Applicant(s)

YANO ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-158305 as evidenced by Takayama (US 6,284,828). The page numbers referred to below correspond to those of the English translation of the Japanese Patent JP 11-158305. JP'305 discloses a porous film being formed from a resin composition containing (A) 25 to 50 parts by weight of polyolefin resin that includes 75 to 98 wt% of linear low density polyethylene and 2 to 25 wt% of branched low density polyethylene and (B) 75 to 50 parts by weight of an inorganic filler and 0.5 to 10 parts by weight of a lubricant (abstract). JP'305 does not specifically disclose a liquid ethylene-alpha-olefin oligomer having been used as a lubricant in the resin composition. Takayama teaches a polyacetal resin composition comprising a lubricant that includes a liquid ethylene-alpha-olefin oligomer, ethylenebissteramide in the amount of 0.5 to 5 parts by weight based on 100 parts by weight of the resin composition in view of the easier preparation of the composition and the improvements of the processability (column 5, lines 31-35, column 8, lines 10-15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the ethylene-alpha-olefin oligomer singly or in combination with the ethylenebissteramide disclosed in JP'305 motivated by the

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desire to facilitate the preparation and the processability of the composition, which is important to the invention of JP'305.

With regard to claim 2, it appears that JP'305 as evidenced by Takayama is using the ethylene-alpha-olefin oligomer having an amount within the claimed range, it is the examiner's position that the viscosity of the ethylene-alpha-olefin oligomer would be inherently present. Products of identical chemical composition can not have mutually exclusive properties. In re Spada, 15 USPQ 2d 1655 (1990).

With regard to claims 3, 4 and 7, JP'305 teaches the porous film having the moisture vapor transmission, uniformity of thickness, and thickness meeting the specific range required by the claims (page 4, [0025]).

With regard to claims 5 and 6, since the porous film of JP'035 as evidenced by Takayama is formed from the same resins having the concentrations within the claimed ranges and the porous film having the moisture vapor transmission, uniformity of thickness meeting the specific range required by the claims, it is the examiner's position that the ratio of the rigidity to the thickness as well as the ratio of the extrudation start time to the thickness would be inherently present. This is in line with In re Spada, 15 USPQ 2d 1655 (1990). Products of identical chemical composition can not have mutually exclusive properties.

3. Claims 1, 2, 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-158305 in view of Kawaguchi et al (US 4,794,128) substantially as set forth in Paper no. 5.

Response to Arguments

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4. The art rejections over JP 11-158305 in view of Kawaguchi have been maintained for the following reasons. The arguments that the disclosure in Kawaguchi would not motivate those of ordinary skill in the art to add liquid ethylene-alpha olefin copolymers to the composition of JP'035 to obtain a porous film having good moisture permeability are not commensurate in scope with claim 1. Nothing specific about moisture permeability has been included in claim 1.
5. The terminal disclaimer filed on 05/21/2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application Number 09/772,854 filed on 01/31/2001 has been reviewed and is accepted. The terminal disclaimer has been recorded. The double patenting rejections have been overcome by the terminal disclaimer.

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
August 2, 2003


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700